

Remarks

The Office Action mailed October 23, 2003, has been received and reviewed. Claims 1 through 17 are currently pending in the application. All claims are subject to a restriction requirement. Applicants hereby provisionally elect, with traverse, to prosecute the claims of Group I, claims 1 through 6, as drawn to the sequence CACCTNCACCT.

Applicants respectfully traverse this restriction and submit that the Groups identified as Groups I-IV in the Office Action should be joined and examined as a single group, which applicants elect. Applicants have amended claim 13 and added new claim 18, which is directed to the elected group. Examination of the application claims is respectfully requested.

The Office Action states that the "inventions in groups I-VII" are "materially different methods that differ at least in objectives, method steps, reagents and/or doses and/or schedules used, response variables, assays for end products and/or results, and criteria for success, and therefore the claimed methods are distinct." (Office Action at page 4).

Applicants respectfully submit that the present invention relates in essence to the DNA binding place of specific zinc finger proteins. As described in the specification, applicants found this binding place should comprise a CACCT sequence, a possible spacer (N) and another CACCT sequence, which may be a corresponding AGGTG sequence (*i.e.* a 5' CACCT on the other DNA strand; *see, e.g.* the specification at paragraphs [0079], [0071] and [0091]). Accordingly, CACCT-N-CACCT, CACCT-N-AGGTG, AGGTG-N-CACCT and AGGTG-N-AGGTG were claimed in claim 2 as each of the possible combinations of 5' CACCT or its corresponding 5' AGGTG on the complementary DNA strand (depending on the direction and the strand of the same DNA molecule a skilled person would consider). As such, it appears that the requirement to select a single one of these sequences treats four configurations of the same molecule (*i.e.*, CACCT-N-CACCT in its most common configuration) as if it were four different molecules.

MPEP §803.04 sets forth:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute

independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.* Nevertheless, to further aid the biotechnology industry without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1198 O.G. 68 (November 19, 1996).

The MPEP goes on to state that “normally ten sequences constitute a reasonable number for examination purposes.”

Since these four different sequences do not encode different proteins, but instead represent four different possible configurations of the same molecule, as discussed previously herein, applicants respectfully submit that Groups I-IV do not represent “material different methods,” and respectfully requests they be joined into a single group for examination. Otherwise, the restriction requirement may preclude applicant from pursuing claims that characterize the invention in multiple aspects. Further, since only four nucleotide sequences are involved, applicants request the requirement be further withdrawn pursuant to the Office practice allowing a reasonable number of independent and distinct nucleotide sequences, to be claimed in a single application.

Applicants note that the Office Action identifies claim 1 as a linking claim, and indicates that, as such, upon its allowance the restriction requirement will be withdrawn. Applicants identify newly presented claim 18 also as a linking claim, which links Groups I-IV identified in the Office Action, as it is directed to a process that “comprises providing cells with a nucleic acid sequence comprising one of the sequence selected from the group consisting of CACCTNCACCT, CACCTNAGGGTG, and AGGTGNCACCT.” (Office Action at page 5). Applicants respectfully submit that claims 2-6 should similarly be considered linking claims as they also include these elements, as should newly present claim 18. In the event the restriction is

not withdrawn upon consideration of this response, applicants request that it be withdrawn pursuant to MPEP §804.01 upon the allowance of any of claims 1 through 6 and 18.

Further, upon reconsideration should the Office determine that these four possible configurations of the claimed molecule represent independent species of the molecule so as to require a species election, applicants will make the same elections for examination of species, as noted above for the restriction requirement, and elect to proceed under 37 CFR § 1.141. In such an event, upon the allowance of any of claims 1 through 6 or 18 each of which is generic for the four identified nucleic acid sequences, applicants ask that the identified species be rejoined and allowed.

Conclusion

For the foregoing reasons, applicants respectfully submit that the Groups identified as Groups I -IV in the Office Action should be joined and examined as a single group, which applicants elect. Applicants request an action on the merits of the claims. Should the Office determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact applicants' undersigned attorney.

Respectfully submitted,



Bretton L. Crockett
Registration No. 44,632
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: November 6, 2003

BLC

Document in ProLaw